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10/735,449	12/12/2003	Shawn David Roman	5490-259COB	2026
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HARNESS, DICKEY & PIERCE, P.L.C.			SHAFTER, RICHARD R	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/735,449	<b>Applicant(s)</b> ROMAN ET AL.
	<b>Examiner</b> Richard Shaffer	<b>Art Unit</b> 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 22 April 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 44-72 is/are pending in the application.  
 4a) Of the above claim(s) 49,63 and 66 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 44-48,50-62,64-65 and 67-72 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date 3/17/2008

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant in the reply filed on December 15<sup>th</sup>, 2006 elected with traverse the species as shown in Figure 15 which depicts a threaded portion and a non-threaded portion of the post, with the head of the post extending from both sides of the base plate. Claims 49 and 66 recite the limitation that the threads extend substantially the entire length of the post. Claim 63 recites that the head rests wholly contained between the first and second ends of the base. Since these limitations are inconsistent with elected embodiment of Figure 15, they are subject to the restriction requirement mailed on November 17<sup>th</sup>, 2006.

Claims 49, 63 and 66 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 15<sup>th</sup>, 2006.

***Double Patenting***

The examiner acknowledges that applicant intends to file a Terminal Disclaimer at a later date. Until such is filed, the Double Patenting Rejection stands.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 44-48, 50-62, 64, 65 and 67-72 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,685,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the two sets of claims lies in the fact that the patent claims includes many more elements and is thus more specific than the application claims. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

#### ***Claim Objections***

The previous claim amendments are now moot in view of the cancellation of previously submitted claims as filed on April 22nd, 2008.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 69 recites "... a first portion having an outer radial surface that is substantially equivalent with an outer radius of a remainder of the post ..." It is unclear what applicant is claiming, especially by stating a surface of one member is equivalent to a radius of another.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 44-48, 50-53, 58-62, 64, 65 and 67-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Hopf (US Patent 5,814,046).

Hopf discloses a device (**Figures 2-7**) comprising: a disk-shaped planar cap (**23**) having an engaging face (bottom surface) with teeth (corners of the flat sides on the base surface); a planar disk-shaped base (**3**) opposing the cap; the base and cap have substantially equivalent diameters (as seen in **Figures 2 and 6**); the base defines a collar by aperture (**7**) disposed offset from both end surfaces; a post (**1**) with threading/ribbing (**11**) along an outboard dimension of the post; the post (**1**) is rotatably attached to the base and cap; the post (**1**) having an enlarged head (**15, 16 and 22 together**) defining a channel (open sided channel) defined on a terminal end (any half of the post can be reasonably interpreted as a terminal end due to distinct portions); the enlarged head engages (located partially within as seen in **Figure 7**) the collar; the post (**1**) having a D-shaped keyed section (**12**) with a torque-limiting section (where **12** turns

to **11**) inherently preventing a level of over tightening of the cap relative to the base; and an applier (**14**, **Figure 5**) having a keyed bore (**28**) to interact with the keyed section **(12)** of post **(1)**.

As best understood in claim 69, the D-shaped keyed section has a radial surface along a portion and a flat along another portion; the radial surface located substantially the same in relation to the center of the post.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44-48, 50-62, 64, 65 and 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerch (US Patent 6,068,631) in view of Hopf.

Lerch discloses (**Figures 1-8**) a titanium (**Column 2, Lines 1-3**) assembly comprising: a disk-shaped cap (**22** and **112b** together) with teeth (**223**); a disk-shaped base (**21**) with slots (**214**) about an aperture (**211**) which defines a collar; the cap (**22** and **112b**) and base (**21**) have substantially the same diameter; a post (**11**) with an enlarged head (**111** and small adjacent portion of **112**) defines a channel; the enlarged head extends proud in both directions from the surfaces of the base (**21**); with the head partially within the collar of the base (**21**); and the post having threads (**112a**) to engage the corresponding mating portion of cap (**112b**).

Lerch discloses all of the claimed limitations except for the post including a D-shaped torque limiting feature to which an applier with a complementary keyed bore engages to rotate the post.

Hopf teaches (as discussed previously) a threaded post with a D-shaped tool engagement end to which an applier engages to rotate the post. It would have been obvious to one having ordinary skill in the art to substitute an end as taught by Hopf to the device of Lerch in order to allow a tool to engage and rotate the post relative to the cap portion (112b). As discussed in reference to Hopf, such a design inherently comprises a torque limiting structure matching all claimed limitations directed towards its shape.

Claims 44-48, 50-59, 61, 62, 64, 65 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuras (US Patent 6,585,739) in view of Hopf.

Kuras discloses a device (**Figures 1-9**) comprising: a cap (50) defining a planar engaging end (could be any of these elements: 84, 98, 104, 74, 76) with teeth (92, 102); a base (44) opposing the engaging end of the cap; the base (44) defining a collar (See **Figure 5** at an aperture 146); a post (46 or 250) having a threading/ribbing extending substantially an entire length of the post; the post having an enlarged head/engaging portion (140) at a terminal end that engages the collar; the enlarged head defines a channel (between 140 and threading 160) which receives a periphery of the base (see **Figure 5**); the post having a keyed section (142) to receive an applier (**Column 4, Lines 40-42**); and the device made of titanium (**Column 3, Lines 15-18**). The cap and base define substantially equivalent diameters (across the shorter distance of 50) and

the collar is defined at a central recess of the base and the enlarged head seats in the central recess.

Kuras discloses all of the claimed limitations except is silent of a D-shaped torque-limiting feature with the applier having a bore keyed to the D-shaped structure. Hopf teaches (as discussed previously) a threaded post with a D-shaped tool engagement end to which an applier engages to rotate the post. It would have been obvious to one having ordinary skill in the art to substitute an end as taught by Hopf to the device of Kuras in order to allow a tool to engage and rotate the post relative to the cap portion (112b). As discussed in reference to Hopf, such a design inherently comprises a torque limiting structure matching all claimed limitations directed towards its shape.

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopf.

Hopf discloses all of the claimed limitations except for the device made of non-resorbable titanium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of titanium, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot due to the cancellation of the original set of claims and composing similar but

different claims requiring a different interpretation of all the references previously used to reject the claims under 35 U.S.C. 102(b) and 35 U.S.C. 103(a).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Shaffer whose telephone number is (571)272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard Shaffer/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733